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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,597

Applicant(s)

GLUCK ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6-9,12-15,17-23,26,28-31,34-37 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-9,12-15,17-23,26,28-31,34-37 and 39-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/23/2004 has been entered.

Response to Amendment

Amendment received on 9/23/2004 is acknowledged and entered. **Claims 2, 3, 5, 10, 11, 16, 24, 25, 27, 32, 33 and 38** have been canceled without prejudice or disclaimer. **Claims 1, 4, 6, 8-9, 12-14, 17-20, 23, 26, 28, 30-31, 38, 41-42 and 45-49** have been amended. **Claims 1, 4, 6-9, 12-15, 17-23, 26, 28-31, 34-37 and 39-49** are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 19-20, 36 and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 36 appear to miss phrases, thereby making claims confusing.

Claims 19-20 and 41-42 are confusing, because the term "the website" lacks antecedent basis.

Claim Objections

Claim 46 is objected to because of the following informalities: **claim 46** recites a method while referring to a system.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4, 6-9, 12-15, 17-22, 45, 47 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972).

Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1, 4, 6-9, 12-15, 17-22, 45, 47 and 49 are completely silent with regard to technology and are purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The claims are no more than a suggested idea of making a decision of what type of energy system is best suited for a customer based on various factors.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either:

(A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, there does not appear to be any physical transformation of data. The method step of: *calculating and providing a proposed energy system configuration and proposed price for the purchase and installation of an energy generation system* may be understood as merely making a determination about type of equipment to be installed at the customer's premises. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although *Bowman* is not precedential, it has been cited for its analysis.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) a computer, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As to "wherein" or "in which" clause, it merely states the intended use of the invention, and adds nothing to the patentability of the claim. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-

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statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7, 8, 12-15, 22, 23, 29, 30, 34-37, 44, 47, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 6,785,592) (Smith).

Smith teaches energy management method and system, comprising:

Claims 1 and 23.

Collecting and storing information related to energy conservation measures; said measures including equipment, energy and capital improvement investments (C. 6, L. 22-30);

collecting and storing information related to energy demand for clients (C. 7, L. 19-23; C. 9, L. 30-34);

calculating and providing a proposed solution for said measures, including: optimization of equipment, costs and operations of energy systems, and replacing energy-related equipment based on the collected information (C. 11, L. 42-54; C. 20, L. 59), wherein said collected information includes: regulatory-related issues (C. 14, L. 46-50), and site related information such as climate, weather and time zone data (C. 14, L. 53-54; C. 15, L. 45-47); and

implementing said measures (C. 6, L. 20), thereby indicating receiving a commitment from an individual client to spend funds for said measures.

Smith does not explicitly teach that an aggregate of the clients commitments to spend funds to implement said measures permits the volume pricing for said energy-related equipment.

However, Smith does teach that said measures include negotiating for obtaining reduced energy rates, including increase the volume of energy consumed at a lower unit price (C. 20, L. 40-41), and optimizing the cost of replacing energy-related equipment (C. 12, L. 42-45; C. 20, L. 59).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Smith to include that said measures includes negotiating for reduced pricing for said energy-related equipment, because it would advantageously reduce overall cost of said energy conservation measures.

Claims 7 and 29. Said method and system, including: collecting and storing information related to energy demand for clients (C. 7, L. 19-23; C. 9, L. 30-34). Information as to *wherein clients comprises any one of the following: private homeowner, multiple dwelling unit owner, ...* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Smith would be performed the same regardless who is the client.

Claims 8 and 30. Said method and system, including: collecting and storing site related information, including climate, weather and time zone data (C. 14, L. 53-54; C. 15, L. 45-47). Information as to *wherein each site comprises any one of the following: private homeowner, multiple dwelling unit owner, ...* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994,

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1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Smith would be performed the same regardless what is the site.

Claims 12 and 34. Said method and system, wherein the clients are kept informed of results of modeling optimum system performance, and continued progression of client's solutions for said energy related conservation measures (C. 13, L. 42-44; C. 10, L. 45-50).

Claims 13 and 35. Said method and system, wherein installation (visiting the client's site) of the equipment and monitoring devices is conducted upon commissioning the project (C. 8, L. 42-52), thereby obviously indicating "time-shifting" feature. Information as to *in which the need to expend capital to visit the individual client site...* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claims 14 and 36. Said method and system, wherein clients are located in different geographical areas (C. 9. L. 30-34).

Claims 15 and 37. Said method and system, including providing nationally available assistance, including support specialists on staff to monitor, record and resolve client issues (C. 13, L. 40-49).

Claims 22 and 44. Said method and system, wherein the costs of energy conservation measures are reduced when the corresponding technology is improved, and less costly or more efficient equipment is utilized (C. 22, L. 26-31).

Claims 47 and 48.

Collecting and storing information related to energy conservation measures; said measures including equipment, energy and capital improvement investments (C. 6, L. 22-30);

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collecting and storing information related to energy demand for clients (C. 7, L. 19-23; C. 9, L. 30-34);

calculating and providing a proposed solution for said measures, including optimization of equipment, costs and operations of energy systems, and replacing energy-related equipment based on the collected information (C. 11, L. 42-54), wherein said collected information includes: regulatory-related issues (C. 14, L. 46-50), and site related information such as climate, weather and time zone data (C. 14, L. 53-54; C. 15, L. 45-47); and

implementing said measures (C. 6, L. 20) thereby indicating receiving a commitment from an individual client to spend funds for said measures.

Smith does not explicitly teach that an aggregate of the clients commitments to spend funds to implement said measures permits the volume pricing for said energy-related equipment.

However, Smith does teach that said measures include negotiating for obtaining reduced energy rates, and optimizing the cost of replacing energy-related equipment (C. 12, L. 42-45).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Smith to include that said measures includes negotiating for reduced pricing for said energy-related equipment, because it would advantageously reduce overall cost of said energy conservation measures.

Claim 49.

Collecting and storing information related to energy conservation measures; said measures including equipment, energy and capital improvement investments (C. 6, L. 22-30);

collecting and storing information related to energy demand for clients (C. 7, L. 19-23; C. 9, L. 30-34);

calculating and providing a proposed solution for said measures, including optimization of equipment, costs and operations of energy systems, and replacing energy-related equipment based on the collected information (C. 11, L. 42-54), wherein said collected information includes: regulatory-related issues (C. 14, L. 46-50), and site

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related information such as climate, weather and time zone data (C. 14, L. 53-54; C. 15, L. 45-47); and

implementing said measures (C. 6, L. 20) thereby indicating receiving a commitment from an individual client to spend funds for said measures.

Smith does not explicitly teach that said collected information, related to energy demand for clients, included volume pricing for said energy-related equipment.

However, Smith does teach monitoring information related to reduced energy rates, and optimization of the cost of energy-related equipment and its replacement (C. 12, L. 42-45).

Therefore, it would have been obvious to one having ordinary skill in art at the time the invention was made to modify Smith to include that said collected information includes volume pricing for said energy-related equipment, because this information would advantageously help to reduce overall cost of said energy conservation measures.

Claims 4 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Ishimaru et al. (US 5,432,710) (Ishimaru).

Claims 4 and 26. Smith teaches said method and system, wherein said collected information includes data on client geographic location (C. 14, L. 53-54); building specific factors (C. 15, L. 45-51); weather data including ambient temperature and humidity, hour of the day, type of the day and solar radiation (C. 16, L. 45-47); applicable tariffs (C. 6, L. 13); and new technology issues including micro turbines (C. 22, L. 10-22).

Smith does not specifically teach that said new technology issues includes information on fuel cells, photovoltaic cells, and wind turbines.

Ishimaru teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the

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customer (C. 10, L. 14 – C. 11, L. 12), wherein said data on energy usage comprises data on historical or anticipated electric power usage and energy generation preferences, including solar cells, fuel cells and wind power generators (C. 9, L. 27-29; C. 10, L. 22-27).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Smith to include that said new technology issues includes information on fuel cells, photovoltaic cells, and wind turbines, as disclosed in Ishimaru, because it would advantageously provide the clients with various sources of energy generation equipment to choose from, thereby providing the best possible optimized solution for said energy conservation measures.

Claims 6 and 28. Ishimaru teaches an energy supply method and system, wherein the energy generation system comprises one of solar cells, fuel cells and wind power generators (C. 9, L. 27-29; C. 10, L. 22-27). The motivation to combine Smith and Ishimaru would be to advantageously provide the clients with various sources of energy generation equipment to choose from, thereby providing the best possible optimized solution for said energy conservation measures.

Claims 9 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Ardalan et al. (US 6,396,839) (Ardalan).

Claims 9 and 31. Smith teaches collecting and transmitting data on energy usage over the Internet (C. 7, L. 50-63).

Smith does not specifically teach that collecting said data over the Internet includes collecting said data interactively from an Internet Web site.

Ardalan teaches a method and system for remote access to electronic meters using a TCP/IP protocol suite, wherein the data on energy usage is collected from an Internet Web site (C. 4, L. 50-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include that the data on energy usage is collected from an Internet Web site, as disclosed in Ardalan, because the Internet is the

largest existing available network, and using the Internet would advantageously be less costly than installing the dedicated network.

Claims 21, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Bezos et al. (US 6,029,141) (Bezoes).

Claims 21 and 43. Smith teaches all the limitations of **claims 21 and 43**, except encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others.

Bezoes teaches a method and system for Internet-based customer referral arrangement, wherein, if the customer selects a referral link, the commission is automatically credited to an account of the referring associate (C. 1, L. 62 – C. 2, L. 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others, as disclosed in Bezoes, because it would allow to increase sales and revenues without adequate spending for advertisement.

Claims 45 and 46. Smith teaches all the limitations of **claims 21 and 43**, except encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others.

Bezoes teaches a method and system for Internet-based customer referral arrangement, wherein, if the customer selects a referral link, the commission is automatically credited to an account of the referring associate (C. 1, L. 62 – C. 2, L. 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others, as disclosed in Bezoes, because it would allow to increase sales and revenues without adequate spending for advertisement. Information as to: *so as to increase aggregate demand, lower the costs... , and to increase environment benefits to society* is non-functional language and given no patentable weight. Non-

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functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claims 17-18 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Ishimaru and further in view of Achon (Building an international plastics base in Spain; April, 1996).

Claims 17 and 39. Smith teaches energy management method and system for developing and implementing energy conservation measures (C. 6, L. 22-30; C. 8, L. 41-43); said developing and implementing is based in part on current state of deregulation (C. 14, L. 46-50).

However, Smith does not specifically address *pollution issues*. Also, Smith does not teach *organizing the clients to advocate politically for regulatory changes*.

Ishimaru teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

Achon teaches development an international plastics center in Spain, wherein local producers are lobbying for reduced energy cost (Page 2; 3rd paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include that said developing and implementing is based in part on new technology issues including non-polluting issues, as disclosed in Ishimaru, because upgrading client's energy-related equipment by non-polluting technology would advantageously bring health benefits to society. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith in view of Ishimaru to include lobbying for reduced energy cost, and

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using electricity generated without causing pollution, as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures, and reduce environmental contamination, thereby decrease the danger of human health.

Claims 18 and 40. Smith teaches energy management method and system for developing and implementing energy conservation measures (C. 6, L. 22-30; C. 8, L. 41-43); said developing and implementing is based in part on current state of deregulation (C. 14, L. 46-50).

However, Smith does not specifically address *pollution issues*. Also, Smith does not teach *organizing the clients to advocate politically for regulatory changes*; and *increasing the number of potential clients by doing so*.

Ishimaru teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

Achon teaches development and international plastics center in Spain, wherein local producers are lobbying for reduced energy cost (Page 2; 3rd paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include that said developing and implementing is based in part on new technology issues including non-polluting issues, as disclosed in Ishimaru, because upgrading client's energy-related equipment by non-polluting technology would advantageously bring health benefits to society. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith in view of Ishimaru to include lobbying for reduced energy cost, and using electricity generated without causing pollution, as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures, and reduce environmental contamination, thereby decrease the danger of human health. Lobbying for reduced energy cost, disclosed in Achon, obviously

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indicates influencing public opinion regarding said issues, thereby obviously causing increase in numbers of potential clients by doing so.

Claims 19-20 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Ishimaru and further in view of "Updated 'Green Schools' site brings energy issues to entire school"; July, 1999; (Publication).

Claims 19 and 41. Smith teaches energy management method and system for developing and implementing energy conservation measures (C. 6, L. 22-30; C. 8, L. 41-43); said developing and implementing is based in part on current state of deregulation (C. 14, L. 46-50).

However, Smith does not specifically address *pollution issues*. Also, Smith does not teach *advertising a website regarding energy alternatives and non-polluting energy system*; and *increasing the number of potential clients by doing so*.

Ishimaru teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

Publication teaches advocating energy efficiency and green schools via a website, including buildings retrofits, changes in operational and maintenance routines; and promoting said measures via a website (Page one). Conducting promotional activities via the website obviously indicate causing advertising of said website.

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Smith to include that said developing and implementing is based in part on new technology issues including non-polluting issues, as disclosed in Ishimaru, because upgrading client's energy-related equipment by non-polluting technology would advantageously bring health benefits to society. And it would have

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been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith in view of Ishimaru to include advocating energy efficiency and green schools via a website, including buildings retrofits, changes in operational and maintenance routines; and promoting said measures via a website and advertising said website, as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures, and reduce environmental contamination, thereby decrease the danger of human health. Promoting said measures via a website, disclosed in Achon, obviously indicates influencing public opinion regarding said issues, thereby obviously causing increase in numbers of potential clients by doing so.

Claims 20 and 42. Smith teaches energy management method and system for developing and implementing energy conservation measures (C. 6, L. 22-30; C. 8, L. 41-43); said developing and implementing is based in part on current state of deregulation (C. 14, L. 46-50).

However, Smith does not specifically address *pollution issues*. Also, Smith does not teach *advertising a website regarding energy alternatives and non-polluting energy system*.

Ishimaru teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

Publication teaches advocating energy efficiency and green schools via a website, including buildings retrofits, changes in operational and maintenance routines, and promoting said measures via a website (Page one). Conducting promotional activities via the website obviously indicate causing advertising of said website.

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Smith to include that said developing and implementing is

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based in part on new technology issues including non-polluting issues, as disclosed in Ishimaru, because upgrading client's energy-related equipment by non-polluting technology would advantageously bring health benefits to society. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith in view of Ishimaru to include advocating energy efficiency and green schools via a website, including buildings retrofits, changes in operational and maintenance routines; and promoting said measures via a website and advertising said website, as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures, and reduce environmental contamination, thereby decrease the danger of human health.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

Applicant's arguments with respect to claims 1, 4, 6-9, 12-15, 17-23, 26, 28-31, 34-37 and 39-49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The best foreign patent located by the examiner:

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GB 2152248 A to Hall; discloses a controller for heating or cooling system configured to maintain energy consumption within a user chosen budget.

The additional best non-patent literature located by the examiner:

"Active Music", the Internet print-out; discloses 25 years of non-profit organization activities, wherein celebrities participate in various public awareness campaigns.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

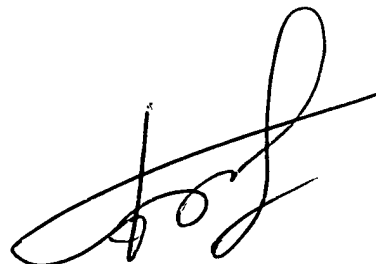
Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
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11/12/2004